

REMARKS

Applicant appreciates the thorough review by Examiner. Applicant previously made amendments to the claims in order to more particularly point out the subject matter of Applicant's invention, and to provide antecedent basis. In particular, claims 57 and 82 were amended to remove the references to one- or two-pack inks and to printing, and to further distinguish the features of the coupling agent as: (a) having a storage life of not less than about three months; (b) being unreactive except at elevated temperature of between 60 and 200°C, at which temperature the one-pack retroreflective ink applied to the substrate is cured; and (c) being selected from the group consisting of an amino alkyl silanetriol and a blocked polyisocyanate. The only current amendments associated with this response are to claims 96 and 114 to correct clerical or typographic errors. Applicant respectfully requests that the Examiner enter Applicant's amendment.

Response to 35 U.S.C. § 103 Rejections

The Examiner maintained the rejections of claims 57, 59, 61, 64-73, 113 and 115 as being obvious under the provisions of 35 U.S.C. § 103(a) in view of JP 02-043275, having Shunichi as a listed inventor (hereinafter "JP '275" or "the JP '275 publication"), in view of Rizika et al., U.S. Patent No. 5,650,213 (hereinafter "Rizika" or "the Rizika patent"). The Examiner also maintained the rejections of claims 63, 60, 81, 104, 114, and 116 as being obvious in light of JP '275 in view of Rizika and WO/95/14248, as well as of claims 117 and 118 in light of JP '275 in view of Rizika and JP 02300253. For each of the rejected claims the Examiner combined the teachings of the JP '275 publication and the Rizika patent as part of, or all of the combination of teachings used to reject the Applicant's claims. Applicant respectfully requests

reconsideration of these rejections in light of Applicant's attached Declaration in addition to Applicant's previous arguments that there was no motivation to combine JP '275 and Rizika, and Applicant's previous arguments that each and every claim element is not disclosed by the teachings of the cited references.

Attached hereto is the Declaration of Brian Sagar PhD under 37 CFR 1.132 as evidence relating to the combination of JP '275 and Rizika, as well as to secondary considerations pertaining to obviousness. As noted by Dr. Sagar, there has been a great commercial success in Applicant's retroreflective inks, with average annual sales in excess of \$350,000 in at least twenty-eight (28) countries. Moreover, sales of fabric and apparel printed with Applicant's retroreflective inks generate average annual sales in excess of \$3,500,000. Dr. Sagar attributes the commercial success of Applicant's retroreflective ink products due to their long shelf lives for use with screen-printing processes over an extended period of time.

Dr. Sagar then provides evidence based upon his expertise as a chemist and his experience in the industry relating to the shelf life of prior art competing products. According to Dr. Sagar, the only successful competing product was sold as three separate packs: (1) a binder dispersion composition; (2) a coupling agent; and (3) hemispherically-coated glass microshperes or beads. Upon mixing the three packs, the product was only able to be used in the screen-printing process for a period of approximately six hours. Any ink leftover after this period had to be discarded. Therefore, at the time of Applicant's invention, there was a long felt but unsatisfied need for a stable retroreflective ink product that could be stored and used in a screen-printing process over a period of time. In response to such need, Dr. Sagar invented Applicant's product, which can be stored and then used for a period of up to one year. Applicant's claimed invention includes the limitation that "the one-pack retroreflective ink having a storage life of not

less than about 3 months." This is a great improvement over the known prior art that helps to satisfy the long felt but unsatisfied need in the industry prior to Applicant's invention.

Dr. Sagar also discusses the JP '275 and Rizika references relied upon in rejecting Applicant's claims. Dr. Sagar initially discusses the reasons why the JP '275 and Rizika references would not be considered by one skilled in the art when attempting to solve the problem of making retroreflective inks that are more stable with longer shelf lives, while also providing a means of ensuring the retroreflective beads are firmly bound into the binder matrix and onto the textile substrate upon curing at an elevated temperature in order to achieve satisfactory washfastness. *See* paragraphs 5-6 of the Sagar Declaration.

Applicant notes that the Examiner did not rely on having to find a reason to combine the relied upon references that was to solve the same problem as that solved by Applicant. Instead, the Examiner provides that one skilled in the art would mix the microspheres in Rizika into the ink composition JP '275 based upon a motivation of an expected enhancement in the appearance of the ink. However, according to Dr. Sagar, this motivation would not exist because it would not be suitable for use as a reflective ink for screen-printing onto a textile substrate. Dr. Sagar provides several reasons that such a combination is not suitable. Perhaps most importantly, according to Dr. Sagar, this combination is not suitable for use for screen-printing because of the inherent risk of blocking the rotary and flat-bed screens used for printing. Therefore, such a combination would not be viewed as desirous by those skilled in the art because of the troubles associated with the printing equipment. Moreover, Dr. Sagar also provides that this combination is not suitable for use for screen-printing because of the organic solvent nature of the volatile constituent, and environmental factors. Further, Dr. Sagar notes that such a combination would not likely be evident to those skilled in the art because the JP '275 composition is solvent based

rather than the aqueous type used in retroreflective ink products that are suitable for screen-printing textile substrates. Applicant respectfully submits that it would not have been obvious to combine JP '275 and Rizika in the manner suggested by the Examiner in light of Dr. Sagar's testimony relating to the commercial success of Applicant's claimed product following the long felt but unsatisfied need throughout the industry, and Dr. Sagar's testimony relating to the lack a motivation for combining the JP '275 and Rizika references. When Dr. Sagar's Declaration is viewed in addition to Applicant's previously submitted arguments pertaining to the properties of Applicant's invention and elements not shown by the cited references, Applicant respectfully submits that Applicants claims are not obvious under 35 U.S.C. § 103 (a) in light of JP '275 and Rizika, or the combination of JP '275 and Rizika with either WO/95/14248 or JP 02300253.

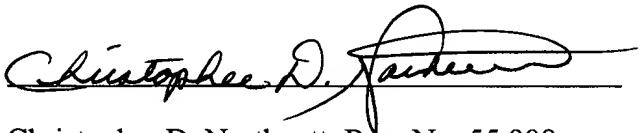
Reconsideration of the application and allowance of all of the claims are respectfully requested. In view of the foregoing Amendment, Applicant respectfully submits that all of the claims are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance.

CONCLUSION

In view of the remarks set forth herein, Applicant respectfully submits that the claims are in condition for examination and the application is in condition for allowance. Accordingly, reconsideration of the application and the issuance of a Notice of Allowance in due course are respectfully requested.

Respectfully submitted,

Dated: August 22, 2005



Christopher D. Northcutt, Reg. No. 55,908
BRACEWELL & GIULIANI LLP
P.O. Box 61389
Houston, Texas 77208-1389
Direct: 713/221-1533
Direct Fax: 713/437-5324

and

James E. Bradley, Reg. No. 27,536
BRACEWELL & GIULIANI LLP
P.O. Box 61389
Houston, Texas 77208-1389
Direct: 713/221-3301
Direct Fax: 713/222-3287
ATTORNEYS FOR APPLICANT